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Hewlett Packard Enterprise  
3404 E. Harmony Road  
Mail Stop 79  
Fort Collins, CO 80528

EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SVEN GRAUPNER, CLAUDIO BARTOLINI, and  
HAMID REZA MOTAHARI NEZHAD

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Appeal 2016-002157  
Application 13/415,814  
Technology Center 3600

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Before JEAN R. HOMERE, JASON V. MORGAN,  
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1–9, which constitute all claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).<sup>1</sup>

We affirm.

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<sup>1</sup> Appellants identify the real party in interest as Hewlett Packard Development Company, LP. Appeal Br. 2.

*Introduction*

Appellants' invention relates to a service/sales feedback collection system for aggregating and evaluating feedback obtained from customers via email. Spec. 3:18–30. In particular, upon receiving survey results from customers (24), case feedback extraction system (CFES 60) extracts character strings therefrom as a way to cluster the emails into sets correlated by the character strings. CFES (60) subsequently evaluates information contained in the emails to answer one or more questions, and to produce aggregate evaluation results into a feedback report. Spec. 7:21–31, Fig. 1.

*Representative Claim*

Independent claim 1 is representative, and reads as follows:

A system comprising:  
one or more processors; and  
memory that stores computer-executable instructions that control the one or more processors to:  
    receive emails including character strings;  
    clustering the emails into sets of emails by correlating emails based on the character strings, each set of emails corresponds to a case;  
    process each set of emails to produce information related to each set of emails;  
    evaluate the information related to each set of emails to answer one or more questions and produce evaluation results;  
and  
    aggregate the evaluation results into a feedback report.

*Rejections on Appeal*

Claims 1–9 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 3.

Claims 1–3 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kannan and McCormick. Final Act. 4–6.

Claims 4–6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kannan, McCormick, and Miloslavsky. Final Act. 6–9.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kannan, Miloslavsky, and Official Notice. Final Act. 9–11.

#### ANALYSIS

We consider Appellants’ arguments *seriatim*, as they are presented in the Appeal Brief, pages 4–13, and the Reply Brief, pages 4–11.<sup>2</sup> We are unpersuaded by Appellants’ contentions. Except as otherwise indicated hereinbelow, we adopt as our own the findings and reasons set forth in the Final Action, and the Examiner’s Answer in response to Appellants’ Appeal Brief. Final Act. 3–10, Ans. 2–17. However, we highlight and address specific arguments and findings for emphasis as follows.

##### *Non-Statutory Subject Matter Rejection*

Appellants argue the Examiner erred in concluding that claims 1–9 are directed to the abstract idea of processing emails to produce business

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<sup>2</sup> Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed July 13, 2015), the Reply Brief (filed December 7, 2015), and the Answer (mailed November 18, 2015) (“Ans.”) for the respective details. We have considered in this Decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(iv) (2014).

information, which the Examiner finds is a fundamental practice. Appeal Br. 8. In particular, Appellants state the following:

[T]he “fundamental economic practice long prevalent in our system of commerce” for businesses to collect information from such sales/customer communications is for the sale personnel to manually enter information from customer interactions into an information system. Such manual information entry puts a burden on the sales personnel, results in only partial information being entered, and in time delays between the occurrence of the interaction and the information being entered into the system.

In contrast...according to the instant application... the system clusters emails into sets by correlating emails based on character strings within emails and process the sets of emails to produce information related to each set of emails. As such, the system of claim 1 is not directed to a judicial exception, but is, instead distinct from the “fundamental economic practice long prevalent in our system of commerce” of manual entry of information from customer interactions by sales personnel.

Appeal Br. 7 (citing Spec. 2:31–4:8).

According to Appellants, the claimed invention “does not seek to tie up the abstract idea of processing emails for information so that others cannot practice it.” *Id.* at 8. Instead, it seeks “[to] prevent others only from clustering emails into cases by correlating emails into sets based on certain characteristics strings within the emails.” *Id.* Appellants contend that the claimed invention recite limitations that are “beyond what is well understood, routine and conventional in the field of business information gathering.” *Id.* at 9, Reply Br. 2–4. Consequently, Appellants submit because the claimed invention includes additional elements amounting to “significantly more than the judicial exception [by adding] improvements to another technology or technical field”, it is directed to patent eligible subject

matter. *Id.* (citing *Alice Corp. Pty Ltd. v. CLS Bank Int'l*, 134 S. Ct 2347, 2354 (2014), *Diamond v. Diehr*, 450 U.S. 175, 177–178 (1981)). These arguments are not persuasive.

The U.S. Supreme Court provides a two-step test for determining whether a claim is directed to patent-eligible subject matter under 35 U.S.C. § 101. *See Alice*, 134 S.Ct. at 2355. In the first step, we determine whether the claims are directed to one or more judicial exceptions (i.e., law of nature, natural phenomenon, and abstract ideas) to the four statutory categories of invention. *Id.* (citations omitted) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)) (“*Mayo*”). In the second step, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citing *Mayo*, 132 S.Ct. at 1297–98). In other words, the second step is to “search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (citing *Mayo*, 132 S.Ct. at 1294).

We agree with the Examiner that under step 1 of the *Alice* analysis, claim 1 is directed to the abstract idea of processing emails to produce business information, which is a fundamental business process performed on a generic computer. Ans. 3. We further agree with the Examiner that the recited steps of receiving, clustering, processing, and aggregating the emails are tantamount to the abstract concepts of organizing, storing, and transmitting information. *Id.* at 13–14; *see, e.g., Elec. Power Grp. LLC v. Alstom*, 830 F.3d 1350 (Fed. Cir. 2016) (characterizing collecting

information, analyzing information by steps people go through in their minds, or by mathematical algorithms, and presenting the results of collecting and analyzing information, without more, as matters within the realm of abstract ideas); *Content Extraction & Transmission v. Wells Fargo Bank*, 776 F.3d 1343 (Fed. Cir. 2014) (characterizing collecting data, recognizing certain data within the collected data set, and storing the recognized data in memory as drawn to an abstract idea). Appellants' preemption argument does not change our analysis. "Where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework . . . preemption concerns are fully addressed and made moot." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) ("While complete preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.")

With regard to step 2 of the *Alice* analysis, we do not agree with Appellants that the cited steps add any meaningful limitations beyond generally linking the abstract idea to the particular technological environment of automatically clustering emails to collect business information therefrom. Appeal Br. 5.<sup>3</sup>

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<sup>3</sup> Considerations for determining whether a claim with additional elements amounts to "significantly more" than the judicial exception itself include improvements to another technology or technical field (*Alice*, 134 S. Ct. at 2359 (citing *Diamond v. Diehr*, 450 U.S. 175, 177-78 (1981))); adding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application (*Mayo*, 132 S. Ct. at 1299, 1302); or other meaningful limitations beyond generally linking the use of the

Independent claim 1 recites “processors” and “memory.” The Specification supports the view that these elements encompass what was generic and common in the field at the time of invention. *E.g.*, Spec. 6:10–7:10. Moreover, the functions performed in claim 1, i.e., receiving, clustering, processing, evaluating, and aggregating, are routine, conventional, and well-known functions, and require nothing more than a generic computer performing generic computer functions. According to Appellants, the conventional technique “is for the sales personnel to manually enter information [which, *inter alia*] puts a burden on sales personnel. . . [whereas] “the system in claim 1 provides a systematic collection of information resulting in more complete and timely information, as well as reducing effort required for sales personnel to enter information.” Appeal Br. 9. However, “relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 701 (2015) (citing *Alice*, 134 S. Ct. at 2359 (“use of a computer to create electronic records, track multiple transactions, and issue simultaneous instructions” is not an inventive concept)). When viewed as a whole, claim 1 is nothing more than performing conventional processing functions that courts have routinely found insignificant to transform an abstract idea into a patent-eligible invention. As such, claim 1 amounts to nothing significantly more than an instruction to implement the abstract idea on a generic computer -- which is

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judicial exception to a particular technological environment (*Alice*, 134 S. Ct. at 2360).



not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2358–2360.

We agree, therefore, with the Examiner that the steps recited in claim 1 do not amount to “significantly more” than the abstract idea under part 2 of *Alice*. Ans. 13–14. Accordingly, we sustain the Examiner’s non-statutory subject matter rejection of claim 1, as well as claims 2–9 not separately argued.

#### *Prior Art Rejections*

Appellants argue that because the teachings of McCormick would render Kannan’s system unsatisfactory for its intended purpose, the proposed combination of Kannan and McCormick is not supported by sufficient motivation, and is thereby improper to render claim 1 unpatentable. Appeal Br. 10–12. In particular, Appellants argue that McCormick’s disclosure of filtering emails into a junk mailbox or an inbox based on character strings extracted from the emails would eliminate the ability of Kannan’s system to “individually process and separately respond to each customer email with an accurate and individualized wait time.” Appeal Br. 11. This argument is not persuasive.

The argument that a proposed combination of references would render one of the references unsuitable for its intended purpose, or would change its principle of operation, is a teaching away argument. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (The court concluded that in effect, “French teaches away from the board’s proposed modification” because “if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose”). The Federal Circuit has held “[a] reference may be said to teach away when a person of ordinary skill,

upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed.Cir.1994)).<sup>4</sup> We agree with the Examiner’s finding that McCormick’s technique of clustering emails based on character strings would enhance (as opposed to change) Kannan’s technique of contacting management via email. Ans. 15. In particular, the proposed combination would predictably result in customers who have submitted similar email requests (i.e. similar character strings or syntax) to the merchant addresses being clustered together such that they would have the same individual wait/response time. Further, Appellants have not proffered any portion of McCormick that discourages, criticizes or otherwise discredits clustering users’ emails based on the commonality of their request, as proposed by the Examiner. For at least the aforementioned reasons, we are not persuaded or error in the Examiner’s rejection of claim 1.

For these reasons, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of claims 1. Because Appellants do not make separate arguments

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<sup>4</sup> “If references taken in combination would produce a ‘seemingly inoperative device,’ . . . such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001) (citation omitted); *see also In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“a reference teaches away from a combination when using it in that combination would produce an inoperative result,” but the obviousness analysis must account for “modifications that one skilled in the art would make to a device borrowed from the prior art”).

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for the patentability of claims 2–9, we sustain the 35 U.S.C. § 103(a) rejections of those claims as well. *See id.*; 37 C.F.R. § 41.37(c)(1)(iv).

#### DECISION

For the above reasons, we affirm the Examiner’s rejections of claims 1–9.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED